

REMARKS

Claims 40-56 are pending in the above application.

STATEMENT OF SUBSTANCE OF INTERVIEW

A personal interview was conducted in the above case on October 5, 2006, and, as an initial matter, Applicant's representatives would like to thank the examiner for the courtesies extended during the interview. The interview was attended by Examiner Cesar Paula and Applicant's representatives Scott Wakeman, Kazuto Iida, and Hitoshi Nohno. Claims 40-56 were discussed as was the reference to Shaw. No exhibits were shown.

During the interview, it was agreed that the above amendment to claim 40 addressed the rejection of claim 40 under 35 U.S.C. 112, second paragraph, and that claim 40 appeared to distinguish over Shaw.

It was also agreed that claim 47 in its present form satisfies the requirements of 35 U.S.C. 112, first paragraph, and appears to distinguish over Shaw.

The examiner explained the basis for rejecting claim 52 under 35 U.S.C. 112, first paragraph. By the above amendment, claim 52 has been amended to recite a step of, in response to the request to run the application using the additional data to be operated upon by the application and before running the application using the additional data to be operated upon by the application, displaying an advertisement based on the additional advertising data. This clarifies that the application itself is running, so that the advertisement can be displayed, and that the advertisement is displayed before running the application using the additional data to be operated upon by the application. With this amendment, it is believed that claim 52 satisfies the requirements of 35 U.S.C. 112, first paragraph. A similar amendment was made to claim 55 which included a limitation similar to the amended limitation of claim 52.

Claim 52 is also rejected under 35 U.S.C. 102(b) as being anticipated by Shaw. It is submitted that at least the limitation "in response to the request to run the application using the additional data to be operated upon by the application and before running the application using the additional data to be operated upon by the application, displaying an advertisement based on the additional advertising data" is not shown or suggested by Shaw. As explained during the

interview, the examiner is interpreting the part of Shaw's e-mail application that communicates over the internet as corresponding to the claimed "application." It does not appear that Shaw ever receives a request to run the communications portion of the email application using additional data to be operated on by the application before running the application or displaying an advertisement based on additional advertising data as required by claim 52, and claim 52 is submitted to be allowable over Shaw for at least this reason.

Finally, the examiner confirmed that the Shaw was being interpreted so that the "additional data" required by claim 52 was advertising data and formatting data for advertising data (such as the PDL file discussed at column 14). To distinguish over this interpretation, new claims 53-56 were provided, each of which includes the limitation "wherein said data to be acted upon by the application does not comprise advertising information or formatting information for advertising information." It would appear that claims 53-55 distinguish over Shaw, and examination and allowance of claims 53-55, presented for the first time with the RCE, is respectfully requested.

CONCLUSION

In view of the above amendments and remarks, it is believed that claims 40-55 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/003,069
Amendment dated October 24, 2006
First Preliminary Amendment

Docket No.: 0033-0778P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

Dated: October 24, 2006

Respectfully submitted,

By 

Charles Gorenstein

Registration No.: 29,271

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant